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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,711	09/15/2003	Zhongmin Liu	2000B043-3	1022

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EXAMINER

JOHNSON, CHRISTINA ANN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/662,711

Applicant(s)

LIU ET AL

Examiner

Christina Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Preliminary Amendment filed September 15, 2003 was improper, as indicated in the Notice of Non-Compliant amendment mailed February 15, 2005. Because no response has been filed within the allotted time period, the preliminary amendment has not been entered and the original claims 1-53 filed September 15, 2003 have been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-8, 11-16, 19-22, and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al.

Miller et al. (US 4,859,312) discloses a catalyst composition useful in hydrocracking and isomerization reactions. The catalyst composition comprises a platinum or palladium hydrogenation component and a molecular sieve such as a SAPO-11 or SAPO-41 (column 2, lines 45-55). It is taught that the hydrogenation

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component may be used in combination with a non-noble metal such as tungsten, vanadium, molybdenum, nickel, cobalt, chromium, or manganese (column 8, lines 50-56). The amount of any one metal ranges from 0.01% to 10% by weight of the molecular sieve (column 8, lines 60-61). The metal component may be added by impregnation (column 8, lines 65-67). Finally, the composition may be combined with a silica or alumina binder (column 9, lines 15-23).

The recitation "surface heat impregnated" and the limitations recited in claims 11-14 and 25-28 are noted by the examiner but have been considered as process of making limitations which do not limit the product as claimed. When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Miller et al.

4. Claims 1-4, 8-9, 11-18, 22-23, 25-29, and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by CN 1,167,654.

CN 1,167,654 discloses a SAPO-34 catalyst which has been modified by a metal such as Cu (page 3, claim 1). The catalysts may be prepared by impregnation (page 8 and page 9). The composition may be used in combination with a binder such as alumina (page 8). The catalyst is useful in the conversion of methanol to olefin (Abstract).

The recitation "surface heat impregnated" and the limitations recited in claims 11-14 and 25-28 are noted by the examiner but have been considered as process of making limitations which do not limit the product as claimed. When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by CN 1,167,654.

5. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Hidaka et al.

Hidaka et al. (US 6,495,724) discloses a catalyst composition useful in the production of methylamines. The catalyst composition comprises silicoaluminophosphates such as SAPO-17, 18, 26, 31, 33, 34, 35, 37, 40, 41, 42, 44, 47, and 56 in combination with a metal such as copper or zinc (column 2, line 66 – column 3, line 1 and column 4, lines 10-20). The metal is contained by a method including impregnation in an amount in the range of 0.05-20% by weight (column 4, lines 45-50 and column 5, lines 1-10). The catalyst composition may be combined with a binder material (column 5, lines 25-30).

The process limitations, i.e. surface heat impregnation limitations, recited throughout the claims are noted by the examiner. However, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is

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shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Hidaka et al.

### ***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 30-48 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 6,448,197. This is a double patenting rejection.

Claims 30-48 are identical to those of US 6,448,197.


### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Johnson whose telephone number is (571) 272-1176. The examiner can normally be reached on Monday-Friday, 7:30-5, with Alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Christina Johnson  
Patent Examiner  
Art Unit 1725  
5/4/05

CAJ  
May 2, 2005